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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,230

04/26/2006

Yoshinobu Abe

2006_0603A

3399

513

7590

12/24/2008

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EXAMINER

CHOI, LING SIU

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,230	Applicant(s) ABE ET AL.	
	Examiner Ling-Siu Choi	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3/ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office action is in response to the Amendment filed 09/04/2008. Claims 1 and 5 were canceled and claims 2-4 and 6-10 are now pending.

Claim Analysis

2. Summary of Claim 2:

A crosslinking agent or a curing agent for resins, the agent containing		
	a polyacrylic hydrazide as an active component, having	
		an average molecular weight of 70,000 to 150,000
		a hydrazide conversion ratio of at least 45%
		400 or more hydrazide groups in one molecule

- Summary of Claim 3:

A crosslinking agent or a curing agent for resins, the agent containing		
	a polyacrylic hydrazide as an active component, having	
		an average molecular weight of 80,000 to 110,000
		a hydrazide conversion ratio of at least 45%
		450 or more hydrazide groups in one molecule

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Summary of Claim 4:

A crosslinking agent or a curing agent for resins, the agent containing		
	a polyacrylic hydrazide as an active component, having	
		an average molecular weight of 80,000 to 90,000
		a hydrazide conversion ratio of at least 50%
		500 or more hydrazide groups in one molecule

Summary of Claim 5:

A crosslinking agent or a curing agent for resins, the agent containing		
	a polyacrylic hydrazide as an active component, having	
		an average molecular weight of 20,000 to 40,000
		a hydrazide conversion ratio of at least 65%
		150 or more hydrazide groups in one molecule

Summary of Claim 6:

A crosslinking agent or a curing agent for resins, the agent containing		
	a polyacrylic hydrazide as an active component, having	
		an average molecular weight of 20,000 to 35,000
		a hydrazide conversion ratio of at least 65%
		150 or more hydrazide groups in one molecule

Summary of Claim 9:

A polyacrylic hydrazide having		
	an average molecular weight of 20,000 to 30,000	
	a hydrazide conversion ratio of at least 70%	

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Summary of Claim 10:

A polyacrylic hydrazide having	
	an average molecular weight of 70,000 to 86,000
	a hydrazide conversion ratio of at least 50%

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartman et al. (US 4,171,413).

Hartman et al. disclose an acrylic polymer containing hydrazide groups comprising the reaction product of (A) an addition polymer formed by vinyl polymerization of 1 to 20 wt% of an α , β - ethylenically unsaturated carboxylic acid and 80 to 99 wt% of at least one vinyl monomer at least a portion of which contains a functional group which is reactive with hydrazine to form hydrazide groups, the vinyl monomer being acrylamide or methacrylamide, and (B) 5 to 40 mol % of hydrazine or an alkyl substituted hydrazine based on total moles of monomers used, wherein the moles of hydrazine or alkyl substituted hydrazine do not exceed the moles of monomers

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containing functional groups reactive with the hydrazine and the amount of hydrazine used ranges from as low as 1 mole percent to as high as 90 mole percent (col. 3, lines 18-21; col. 4, lines 18-20; claims 1 and 8-9). Hartman et al. further disclose "If polymers of relatively low molecular weight are desired (for example, below 40,000) so that they can be dissolved at high solids and low viscosities, a chain modifying agent or chain transfer agent is ordinarily added to the polymerization mixture" (col. 3, lines 27-31). Thus, the present claims are anticipated by the disclosure of Hartman et al.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 4,171,413).

Hartman et al. disclose an acrylic polymer containing hydrazide groups comprising the reaction product of (A) an addition polymer formed by vinyl polymerization of 1 to 20 wt% of an α , β - ethylenically unsaturated carboxylic acid and 80 to 99 wt% of at least one vinyl monomer at least a portion of which contains a functional group which is reactive with hydrazine to form hydrazide groups, the vinyl

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monomer being acrylamide or methacrylamide, and (B) 5 to 40 mol % of hydrazine or an alkyl substituted hydrazine based on total moles of monomers used, wherein the moles of hydrazine or alkyl substituted hydrazine do not exceed the moles of monomers containing functional groups reactive with the hydrazine and the amount of hydrazine used ranges from as low as 1 mole percent to as high as 90 mole percent (col. 3, lines 18-21; col. 4, lines 18-20; claims 1 and 8-9).

The difference between the present claims and the disclosure of Hartman et al. is the requirement of the polyacrylic hydrazide having specific range of average molecular weight.

Hartman et al. disclose “[p]referably, the molecular weight of the addition polymer used in the practice of the invention is at least 3,000 and more preferably between 5,000 and 300,000 on a weight average basis. Polymers with molecular weights above 300,000 have very high viscosities for coating applications and must be diluted to very low solids content to be usable. Addition polymers as used in the practice of the invention with molecular weights below 5,000 are very difficult to prepare (col. 3, lines 18-26). The caselaw has held that “A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieved a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” *In re Antonie*, 559 f.2d 618, 195 USPQ 6 (CCPA 1977). **Since the molecular weight is recognized by Hartman et al. as result-effective variable**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the molecular weight of the polyacrylic

hydrazide by routine optimization and thereby obtain the present invention.

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe et al. (JP 62-072742) in view of Hartman et al. (US 4,171,413).

Abe et al. disclose an aqueous dispersion composition of **self-crosslinkable resin** obtained by mixing (A) an aqueous dispersion of an acrylic copolymer having ≥ 2 hydrazine residues with (B) an aqueous dispersion of a carbonyl-containing copolymer, wherein the component (A) is obtained by reacting hydrazine hydrate to an aqueous dispersion of an acrylic copolymer having amide group (abstract).

The difference between the present claims and the disclosure of Abe et al. is the requirement of polyacrylic hydrazide having specific average molecular weight to be used in the present claims.

Hartman et al. disclose an acrylic polymer containing hydrazide groups comprising the reaction product of (A) an addition polymer formed by vinyl polymerization of 1 to 20 wt% of an α , β - ethylenically unsaturated carboxylic acid and 80 to 99 wt% of at least one vinyl monomer at least a portion of which contains a functional group which is reactive with hydrazine to form hydrazide groups, the vinyl monomer being acrylamide or methacrylamide, and (B) 5 to 40 mol % of hydrazine or an alkyl substituted hydrazine based on total moles of monomers used (col. 3, lines 18-21; col. 4, lines 18-20; claims 1 and 8-9). Hartman et al. disclose "[p]referably, the molecular weight of the addition polymer used in the practice of the invention is at least 3,000 and more preferably between 5,000 and 300,000 on a weight average basis.

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Polymers with molecular weights above 300,000 have very high viscosities for coating applications and must be diluted to very low solids content to be usable. Addition polymers as used in the practice of the invention with molecular weights below 5,000 are very difficult to prepare (col. 3, lines 18-26). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize polyacrylic hydrazide having the specific molecular weight in the disclosure of Abe et al. and thereby obtain the present invention.

Response to Arguments

8. Applicant's arguments filed 09/04/2008 have been fully considered but they are not persuasive.

“.....Applicants contend neither of these references suggest the claimed invention because they fail to suggest the importance of the claimed average molecular weight..... For example, referring to Table 1 on page 24 of the specification, resin composition 9, which corresponds to the aminated polyacrylamide of Abe et al. with a molecular weight of **45,000**, has inferior water resistance. Further, referring to Table 1, resin composition 4 which incorporates polyacrylic hydrazide having a molecular weight of **10,000** is inferior in water resistance.”

These results only demonstrate that the use of the polymer having a molecular weight outside the claimed range of [20,000-30,000] leads to an inferior water resistance. However, for claims having a molecular weight ranging from 70,000 to

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150,000; 80,000 to 110,000; or 80,000 to 90,000, such results do not lead to unexpected results for these claims. It is noted that claims 6 and 9 recite the molecular weight of [20,000-30,000], which are rejected over Hartman et al. (US 4,171,413) under 35 USC 102(b). Thus, such unexpected results will not obviate 35 USC 102(b) rejections.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

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If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114.

/Ling-Siu Choi/

Primary Examiner, Art Unit 1796

December 20, 2008

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